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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,410	07/27/2006	Takahiro Honda	06492/HG	7279

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FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
220 Fifth Avenue
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EXAMINER

SOLOLA, TAOFIQ A

ART UNIT	PAPER NUMBER
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1625

MAIL DATE	DELIVERY MODE
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01/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/587,410

Applicant(s)

HONDA ET AL.

Examiner

Taofiq A. Solola

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 14 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1</u> . | 6) <input type="checkbox"/> Other: _____ |

Claims 1-13 are pending in this application.

Claims 12-13 are drawn to non-elected invention.

Response to Restriction Requirement

The election of group I, claims 1-11 in part, in the Paper filed 12/14/07, is hereby acknowledged. There is no indication as to if the election is made with or without traverse. Therefore, it is deemed made without traversal. It should be noted that examples 4-34 to 4-45 are included in group I, and not "4-34, 4-45" as indicated by applicant in the response. Also, example 3-7 is listed in group I in the last Office action. This is in error. Example 3-7 belongs in groupie and is deemed non-elected by applicant. Claims 1-11 in part, are being examined according to applicant's election and the examples as stated herein.

Applicant asks if group VII embraces "all" compounds not in I-VI and therefore, a combination of groups I-VII implies all compounds within the scope of claim 1. This is partially correct because group VII is any one, two . . . or all the compounds not in listed in groups I-VI but disclosed in the specification. Group VII make possible examination of the full scope of claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Head et al., WO 9937618 (US equivalent 6,329,372 B1).

Head et al., disclose compounds of formula I, specific examples and compositions thereof, wherein A is optionally substituted pyridine, one of R1 is H the other is phenyl, and B is substituted alkyl. See examples on the attached abstract.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manley et al., WO 01/55114, and Chen et al., WO 02/066470, individually, in view of King, Med Chem: Principle and Practice (1994), p. 206-208.

Applicant claims compounds of formula I and their composition as angiogenesis inhibitors.

Determination of the scope and content of the prior art (MPEP 2141.01)

Manley et al., teach similar compounds and their compositions as angiogenesis inhibitors. See the abstract, pages 1-2, formula I and the examples on pages 40-46.

Chen et al., teach similar compounds and their compositions as angiogenesis inhibitors. See the abstract, pages 1-6, formula I and the examples on pages 207-219.

Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)

The difference between the instant invention and that of Manley et al., and Chen et al., is that in compounds of the prior arts, applicant replaced -NH- with -S- on ring A.

Finding of prima facie obviousness--rational and motivation (MPEP 2142.2413)

However, King teaches that replacement of -NH- with -S- in a compound is expected to produce compounds having similar biological activity (bioisosterism). See page 208, bivalent equivalents. See also, *Ex parte Engelhardt*, 208 USPQ 343 (Bd. Pat. App. & Int., 1980); *In re Merck*, 231 USPQ 375 (Fed. Cir. 1986). Therefore, the instant invention is prima facie obvious from the teachings of Manley et al., Chen et al., and King. One of ordinary skill in the art would have known to replace -NH- with -S- on ring A at the time the instant invention was made. The motivation is from knowing that -NH- and -S- are bioisosteres equivalents.

Alternatively, given the teachings of the prior arts, it would have been obvious to try replacement of -NH- with -S- on ring A at the time the invention was made.

When there is motivation

to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under [35 USC] 103.

KSR Int'l Co. v. Teleflex Inc., 127 S.Ct 1727,-----, 82 USPQ2d 1385, 1397 (2007).

Alternatively, applicant has done nothing more than substitutes known bioisosteres equivalents in of prior arts' compounds. However, such substitution is obvious from the prior arts and knowledge of bioisosteres equivalents. "When a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *United States v. Adams*, 383 U.S. 49, 50-51 (1966). Cited in *KSR Int. Co. v. Teleflex Inc*, 550 U.S. ----, 82

USPQ2d 1385 (2007). The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR, supra*.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-11 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-15, 21 of copending Application No. 10/548,283. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Application/Control Number:
10/587,410
Art Unit: 1625

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A handwritten signature in black ink, appearing to read 'Taofiq Solola', with a stylized, overlapping flourish at the beginning.

TAOFIQ SOLOLA
PRIMARY EXAMINER

Group 1625

January 11, 2008